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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,756

11/17/2003

George S. Pabis

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09/18/2006

KENYON & KENYON LLP
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NEW YORK, NY 10004

EXAMINER

PALABRICA, RICARDO J

ART UNIT

PAPER NUMBER

3663

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,756

Applicant(s)

PABIS ET AL.

Examiner

Rick Palabrica

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's 6/26/06 amendment, which directly amended claim 1, amended the drawings, and traversed the rejection of claims in the 3/13/06 Office action, is acknowledged.

Response to Arguments

2. Applicant argues that the examiner's rejection of the limitations, "alignment pins", "shaft", "lower lock fingers", "finger tabs" and "mandrel" for having insufficient antecedent bases is improper because: a) the specific limitation is not preceded by the word, "the"; and b) the recitation of the particular limitation in the claim is its first citation.

The examiner disagrees. The preamble is directed to a method of handling a pressurized water reactor fuel assembly by a broadly recited, "tool." Not all tools for handling such fuel assembly inherently include alignment pins, shaft, lower lock fingers, finger tabs and mandrel, which elements are positively recited in the body of the claim(s). Accordingly, these limitations have no proper antecedent bases in the claim(s).

3. Applicant traversed applied art Salton et al. on the grounds that: a) in their tool, "the gripping members do not grab a dimpled area, but are instead fully inserted into the length of the guide tube"; b) they "teach away from engaging the lock fingers into the divots to an extended position"; and; c) their tool does not disclose the configuration of 1) "wherein structural load of the lifted fuel assembly passes to the tool during the lifting

of the fuel assembly through the lock fingers positioned in the divots of the guide tube thimble”; and 2) “divots formed by swaging of the guide thimbles to the guide thimble sleeves that attach a top nozzle of the fuel assembly to the guide thimbles.” The examiner disagrees.

As to argument a), the above-cited features upon which the applicant relies (i.e., gripping members grabbing a dimpled area and NOT fully inserted into length of guide tube) are not recited in rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, if said unrecited features are considered by the applicant to be critical to his invention, then such omission would amount to a gap between the essential elements. In this case, the claim(s) would be incomplete and would be rejected under 35 U.S.C. 112, second paragraph. See MPEP § 2172.01.

As to argument b), see section 5 of the 3/13/06 Office action discusses how the tips of Salton et al.’s sleeve 64 (which reads on claim language, “lock fingers”) engages the indentation on the guide thimble. As noted before, the dimensions of applicant’s claimed divots are not defined and absent such definition, the inherent indentation caused by the tips of sleeve 64 reads on claim language, “divot”.

As to argument c1), note the following statement of Salton et al.

“One of the main features of the tool 20, which prevents the fuel assembly 52 from slipping off the gripping members 49 as would occur in a conventional tool, is the redistribution of the load path. When a fuel assembly has been gripped by the sleeve 64, and the fuel assembly 52 is then lifted, the design of the tool of the present invention allows the weight of the fuel assembly to 52 to actually increase the gripping force. As the lifting apparatus 20 and fuel assembly 52 thereon are lifted by the lifting means or hoist

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(not shown) which is operably associated with the lift plate 42 by the bail 29 on the elongated mast 23, the load is distributed along the elongated mast 23 to the lift plate 42, to the gripper rod 56 secured to the lift plate 42, down to gripper rod 56 to the first frustoconical surface 59. Underlining provided. See paragraph bridging cols. 4 and 5.

This statement clearly shows how the structural load of the fuel assembly passes to the tool during the lifting process in Salton et al.

As to argument c2), this is a product-by-process limitation. The “product” is “divots” and the “process” defines how the divots are formed, i.e., by swaging the guide thimbles to the guide thimble sleeves. See MPEP 2113, which states:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966.

See above discussion of Salton et al.'s indentation on the guide thimble.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reasons are the same as those stated in section 4 of the 3/13/06 Office action, as further clarified in section 2 above, which reasons are herein incorporated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Salton et al. (U.S. 4,834,934).

The reasons are the same as those stated in section 5 of the 3/13/06 Office action, as further clarified in section 3 above, which reasons are herein incorporated.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RJP
August 28, 2006


RICARDO J. PALABRICA
PRIMARY EXAMINER